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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	MIME-0003	4323
23550	7590	01/13/2012		
HOFFMAN WARNICK LLC				
75 STATE STREET				
14TH FLOOR				
ALBANY, NY 12207				
EXAMINER				
QUELER, ADAM M				
ART UNIT		PAPER NUMBER		
2177				
NOTIFICATION DATE		DELIVERY MODE		
01/13/2012		ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF STEWART and JENNIFER R. PINCO

Appeal 2011-011457
Application 09/709,433
Technology Center 2100

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing (hereinafter “Request”) under 37 C.F.R. § 41.52(a)(1) for reconsideration of our Decision of Nov. 2, 2011 (hereinafter “Decision”).

The Decision affirmed-in-part the Examiner's rejections of claims 12-16, 20-27, and 31-43, as follows:

1. We reversed the Examiner's decision rejecting claim 41 under § 102(e).
2. We reversed the Examiner's decision rejecting claims 13, 14, and 37-40 under § 103(a).
3. We affirmed the Examiner's decision rejecting claims 12, 15, 16, 20-27, 31-36, 42, and 43 under § 103(a).

In the Request, Appellants seek reconsideration of our Decision affirming the Examiner's rejection of independent claims 12, 20, 24, 31, and 42 under § 103(a). (Request 1).

For convenience, we reproduce independent claim 12 below:

12. A method of previewing a document over a network, the method comprising:

providing system software for use on a client, wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file;

obtaining the print file from the system software
executing on the client on the server; and

providing a configuration wizard for display in a
browser on the client in response to a request from the
client.

(emphasis added).

In particular, we observe that claim 12 recites a disputed “at least one of” clause of the following form:

providing system software for use on a client,
wherein the system software allows a user of the client to
use an application configured to at least one of:

(A - display) or (B - edit),

and, (C – in response to the request)

and (D – recited negative limitation),

(E - generate a print file).

(F - transmit the print file . . . in response to the
generation).

and (G - prompt the user . . . in response to the
transmission of the print file);

Regarding the aforementioned clause of claim 12, Appellants present
the following arguments:

- 1) The rejection of independent claim 12 should be reversed because the Board’s claim construction and rationale differs from the Examiner’s interpretation and thus constitutes a new ground of rejection. In support, Appellants cite *In re Stepan Co.*, 660 F.3d 1341 (Fed. Cir. 2011). (Request 5).
- 2) The Board’s construction of the “configured to at least one of:” language of claim 12 is not grammatically correct and renders the clause meaningless. (Request 5-6).

- 3) The Board's construction of the "providing system software" clause of claim 12 is not reasonable when viewed in light of the Specification. (Request 7).
- 4) The Board's construction of the "providing system software" clause of claim 12 requires consideration of *all* of the elements in the conjunctive list that is recited following the "at least one of" language, in light of *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004). (Request 8).

We have reconsidered our Decision of Nov. 2, 2011, in light of Appellants' arguments in the Request. We note that each of the aforementioned arguments 1-4 turns upon the proper claim construction to be accorded to independent claim 12.

Based upon our review of the record, we conclude that claim 12 is subject to two alternative interpretations regarding the scope of "an application configured to at least one of:" and the language that immediately follows. (*See* Claim 12 as reproduced with emphasis above; *see also* Request 4-9 describing in detail the claim construction issue).

We note that Appellants have addressed both interpretations in the Request and even propose "removing and/or modifying the 'at least one of' language" by amendment. (Request, 9).¹ Thus, on this record, we conclude that both interpretations of the aforementioned language of claim 12 are plausible.

¹ We note that Appellants may only amend after the date of filing a notice of appeal pursuant to 37 C.F.R. §41.31(a), if the amendment meets the criteria of 37 C.F.R. §41.33.

We note that “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim . . . indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential). *See also In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.).

This reasoning is applicable here. Therefore, we grant Appellants’ Request to the extent that we modify our Decision and reverse *pro forma* the Examiner’s obviousness rejection of independent claim 12 over the combination Adamske and Tonkin. *See Steele*, 305 F.2d at 862.

Consistent with the holding of *Steele*, we also reverse the Examiner’s obviousness rejection of dependent claims 15, 16, and 32-34, which depend from independent claim 12. (Claims 13 and 14 also depend from independent claim 12 and were reversed in our Decision at page 12).

We emphasize that our reversal is based on procedure rather than on the merits of the obviousness rejection. The reversal does not mean that we consider the claims to be patentable as presently drawn.

In addition, in a new ground of rejection, we reject independent claim 12 and associated dependent claims 13-16, and 32-34 under 35 U.S.C. § 112, second paragraph, as being indefinite. *See Miyazaki*, 89 USPQ2d at 1211.

Independent Claims 20, 24, 31, and 42

Appellants present additional arguments regarding claims 20, 24, 31, and 42. (Request 10-11). However, Appellants have not pointed to where

the arguments advanced in the Request for claims 20, 24, 31, and 42 were raised in the principal Brief (filed Feb. 4, 2011). “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision); *see also Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir 2008) (arguments not made are waived). Thus, waiver applies to these claims irrespective of Appellants’ arguments regarding independent claim 12. (Request 10-11).

Therefore, we deny Appellants’ request to reverse our Decision sustaining the Examiner’s obviousness rejection of independent claims 20, 24, 31, and 42. (Request 10-11). Our reasons for sustaining the Examiner’s rejection of claims 20, 24, 31, and 42 are set forth in our Decision, which we incorporate herein by reference. (Decision 12-15).

DECISION

We reverse the Examiner’s rejection of claims 12, 15, 16, and 32-34, under 35 U.S.C. § 103(a) as being unpatentable over the combination Adamske and Tonkin. In a new ground of rejection, we reject claims 12- 16, and 32-34 under 35 U.S.C. § 112, second paragraph, as being indefinite.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

ORDER

REQUEST GRANTED-IN-PART, DENIED-IN-PART

AFFIRMED-IN-PART 37 C.F.R. § 41.50(b)

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